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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JUNE 4, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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The Scientist, Inc.  
v.  
MicroMath, Inc.

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Cancellation No. 23,598

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Stephen J. Myers of Seidel, Gonda, Lavorgna & Monaco for The  
Scientist, Inc.

Charles L. Roberts of Madson & Metcalf for MicroMath, Inc.

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Before Hanak, Hohein and Quinn, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

The Scientist, Inc. has petitioned to cancel the  
registration owned by MicroMath, Inc. for the mark SCIENTIST  
for "computer software and instruction manuals sold as a  
unit for performing numerical analysis and plotting."<sup>1</sup>

As grounds for cancellation, petitioner asserts  
priority and likelihood of confusion under Section 2(d) of  
the Trademark Act, contending that respondent's mark, when

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<sup>1</sup> Registration No. 1,848,523, issued August 9, 1994.

applied to respondent's goods, so resembles petitioner's previously used and registered mark THE SCIENTIST for a "newspaper"<sup>2</sup> as to be likely to cause confusion.

Respondent, in its answer, denied the salient allegations comprising the priority and likelihood of confusion claim.

The record includes the pleadings; the file of the involved registration; and both a certified copy of petitioner's pleaded registration and respondent's responses to petitioner's interrogatories and request for production, introduced by way of petitioner's notice of reliance. In addition, petitioner offered the testimony, with exhibits, of its chief operating officer. Respondent did not take testimony or offer any other evidence. Both parties filed briefs on the case. Only petitioner's counsel appeared at an oral hearing held before the Board.

Petitioner publishes a newspaper twenty-four times per year. Although the newspaper originally targeted readership in all of the scientific disciplines, it has narrowed its focus primarily to the life sciences. More specifically, according to Alfred Welljams-Dorof, petitioner's chief operating officer, the newspaper concentrates on the business of science, with articles about companies, career interests, job opportunities, salaries and the like. Mr.

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<sup>2</sup> Registration No. 1,479,185, issued March 1, 1988 on the

Welljams-Dorof testified that readership surveys show that petitioner's newspaper has been identified as "the most credible source on the business of science, the business of professional interests of scientists." (dep., p. 26) In a section of the newspaper captioned "Tools and Technology," opposer covers developments in computer hardware and software. THE SCIENTIST newspaper was launched in 1986, and current figures show circulation at slightly above 50,000. The newspaper is also accessible as an electronic publication on the Internet free of charge, and the Web site averages about 40,000 hits per month. Mr. Welljams-Dorof described petitioner's newspaper as a "controlled-circulation publication meaning that we're not going after subscriptions, but we're being distributed by about eight or nine professional societies." (dep., p. 22) A large percentage of the newspapers are distributed for free, with most of the newspaper's revenue coming from running others' advertisements in the publication. These advertisements include some for software. Promotional expenditures have exceeded \$7 million. The newspaper is advertised through direct mailings, distribution of media kits, and attendance at trade shows.

Respondent sells computer software under the mark SCIENTIST for use in fitting experimental data to user

defined equation systems. The mark has been in use since 1993. The goods are sold through direct mail and through distributors and resellers for sale, ultimately, primarily to Ph.D. researchers in academic or corporate settings. The goods are advertised in magazines and through direct-mail solicitations. The computer software, depending on the version, has a price range of \$295-\$395.

Respondent, in its brief, does not dispute petitioner's priority of use. Moreover, the record establishes that petitioner's first use predates respondent's first use.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below.

With respect to the marks, THE SCIENTIST and SCIENTIST differ by only the presence of the definite article "the" in petitioner's mark. The marks are virtually identical in terms of sound, appearance and meaning.

In comparing the marks, we have kept in mind the weakness of the term "SCIENTIST" in petitioner's mark. Petitioner's pleaded registration issued on the Supplemental Register. In its petition for cancellation, however,

petitioner alleged that it has expended considerable effort and expense in promoting its mark with the result that the purchasing public has come to know, rely upon, and recognize petitioner's mark as a source indicator, and that petitioner has an exceedingly valuable goodwill established in its mark.<sup>3</sup> Petitioner then contends in its brief that its mark has acquired distinctiveness and that it is entitled to claim the benefits of Section 2(f) of the Act.

After reviewing the record, we are constrained to agree with petitioner that its mark THE SCIENTIST, as used in connection with its newspaper, has acquired distinctiveness. The evidence of record bearing on this point includes the following: over ten years of continuous use with no knowledge of any use by others of similar marks for similar goods; testimonials from scientists and researchers, published in petitioner's newspaper, attesting to the value of reading THE SCIENTIST; a circulation of over 50,000 readers; and over \$7 million in promotional expenditures.

Accordingly, we find that petitioner's mark has acquired distinctiveness. Nonetheless, due to the weakness of the term "SCIENTIST" in petitioner's mark, a term which is readily understood and which clearly identifies the reading audience of petitioner's newspaper, the mark is entitled to what is sometimes termed a narrow scope of

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<sup>3</sup> We find that this pleading, when construed liberally, can be

protection. In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) ["The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely."]; see also: In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Gruner & Jahr USA Publishing v. Meredith Corp., 991 F.2d 1072, 26 USPQ2d 1583 (2d Cir. 1993).

The crux of the present controversy centers on the relatedness of the goods. The nature of petitioner's "newspaper" is revealed in its "Editorial Overview" (part of petitioner's ex. 29):

*The Scientist* is the only independent news magazine for the life sciences professional. Its editorial mission is unique--to focus on the professional and career interests of scientists working in industry, academia, government, and independent research labs.

Many other publications present original research papers or coverage of new discoveries. Only *The Scientist* delivers comprehensive reports on the issues and events that directly affect the careers of life scientists. These include: current funding trends in the public and private sectors; government legislation, regulation, and policymaking; salary surveys and employment forecasts; hot research areas and the career opportunities they present; the economic impact of technology transfer, licensing, and

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viewed as encompassing a claim of acquired distinctiveness.

patenting; mergers and acquisitions by R&D-intensive corporations; and the ethical debates arising at the interface between science and society.

To best meet its unique mission, *The Scientist* is strategically organized into five distinctive sections: News, Opinion, Research, Profession, and Tools & Technology.

The specific nature of respondent's computer software for performing numerical analysis and plotting is spelled out in the introduction to the user's handbook for respondent's product:

SCIENTIST was designed to provide a comprehensive solution to the problem of fitting experimental data under Microsoft Windows on MS-DOS based microcomputers. It includes the capability of solving systems of model equations that can include nonlinear equations, ordinary differential equations and Laplace transforms. SCIENTIST is a package for researchers who "know what's going on" with their data and need to establish solid parameter values to model real-world phenomena. The easy-to-use interface in SCIENTIST greatly facilitates model entry and manipulation, data management, and control of initial estimates and constraints on parameter values, as well as statistics and graphics output.

The interactive nature of SCIENTIST leads to a higher likelihood of finding optimal parameter values than if fitting were done in batch results. It also enables users to develop a much greater awareness of the sensitivity of models to parameter values. With this program, the power of present day 80386, 486 and Pentium machines makes it entirely feasible to develop and fit complicated

models using nonlinear, differential,  
and Laplace transform equations on  
microcomputers.

Petitioner contends that the parties' newspaper and software are related, that both products are directed to the scientific and research community, and that purchasers would expect the products, when sold under virtually identical marks, to emanate from the same source. Petitioner makes much of the fact that its newspaper includes advertisements for computer software and that editorial material covers the topic of computer software. Petitioner also points out that it is considering making its newspaper available on a CD-ROM and petitioner contends that this product, like respondent's software, would be used with computers.

Based on the record before us, we simply find too tenuous the connection between, on the one hand, petitioner's newspaper, which is directed to the business of science (as opposed to a technical science publication) and, on the other hand, respondent's highly technical and specialized computer software that is designed to fit model equations to experimental data. The record is devoid of any evidence showing that newspaper publishers have branched out into the selling of computer software. It is not surprising, therefore, that Mr. Welljams-Dorof testified that petitioner has no plans or interest in breaking into the business of producing or selling computer software. In



short, the record does not establish any rational reason why highly educated scientists and researchers would ascribe a common source to petitioner's newspaper and respondent's software, even when sold under virtually identical marks.

Another factor in applicant's favor is the sophistication of purchasers. As noted above, both parties' products are directed to highly educated scientists and researchers. Although such individuals are not immune from confusion as to source, the differences between the products would suggest that these purchasers would not be so confused even when confronting the virtually identical marks involved here.

Petitioner claims that its newspaper is "well-known and highly regarded in the scientific community." (brief, p. 4) To the extent that petitioner would have us conclude that its mark is famous, the evidence falls short. Although petitioner's mark may enjoy some notoriety in a narrow field, we cannot conclude on the present record that the mark THE SCIENTIST has achieved the status of a "famous" mark even in that narrow field. Cf.: *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

With respect to the presence of actual confusion, the only portion of the record pertaining to this du Pont factor is Mr. Welljams-Dorof's testimony with respect to exhibit 3,

which appears to be a handbook for using applicant's product, that he was confused "when I first saw it," thinking that "it might be one of our old media kits, because the prominent headline is 'Scientist.'" (dep., p. 49) Suffice it to say that this evidence is hardly the type of evidence which is probative in showing actual confusion as to source. The remainder of the evidence shows that neither side is aware of any reported instance of actual confusion in the marketplace during the more than three years of contemporaneous use of the marks.

Based on the record before us, we view the likelihood of confusion claim asserted by petitioner as amounting to only a speculative, theoretical possibility in a purchase made by highly educated scientists and researchers. The goods of the parties are distinctly different, noncompetitive and used for totally unrelated purposes. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing Witco Chemical Co. v. Whitfield Chemical Co., Inc.,

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418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g  
153 USPQ 412 (TTAB 1967).

In sum, we find that, in light of the weakness of the  
term "SCIENTIST" in petitioner's mark, the differences  
between the parties' goods, and the highly educated  
purchasers thereof, confusion is not likely to occur in the  
marketplace.

Decision: The petition for cancellation is denied.

E. W. Hanak

T. J. Quinn

G. D. Hohein  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board